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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

530 VIRGINIA ROAD

P.O. BOX 9133

CONCORD, MA 01742-9133

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/823,368
Filing Date: April 12, 2004
Appellant(s): BOGEN ET AL.

Mr. James Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/23/08 appealing from the Office action mailed 1/17/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

In the interest of reducing the issues for consideration, the Office has vacated Copeland et al. and Rogers et al. under 35 USC 103 because it is believe these references are redundant to the references cited below.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,089,229	Heidt et al.	2-1992
5,075,079	Kerr et al.	12-1991
5,819,842	Potter et al.	10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,5-8,10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt et al. or Kerr et al. in view of Potter.

Heidt et al. teach an analyzer comprising a rotatable turntable to hold a plurality of reagent test slides, a sample metering device, an incubator/temperature controller and the associated electronics and software(abstract). Figure 8a teach turntable(50) holds slides(71) and heater plate(380) is beneath the turntable(50) to heat the slides(71). Pipette(18) is automatically controlled and supplies the sample to each slide. The claimed *"platform supporting a plurality of microscope slides"* has been read on the taught **turntable(50)**. The claimed *"electric heater thereunder ... temperature sensor"* has been read on the taught **heater plate(380)** and **temperature controller**. The claimed *"liquid dispenser"* has been read on the taught **sample metering device**.

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The claimed “*microprocessor*” has been read on the taught **associated electronics and software**.

Kerr et al. teach a slide analysis system comprising a slide holding module, an incubator module and a metering device to manage the transfer of fluids (abstract). Incubator(14) supports slide modules(24) and is heated by heater(188). Depositing module(16) adds the sample and reagents. Computer control(20) programs and controls all operations using a computer(542). The claimed “*platform supporting a plurality of microscope slides*” has been read on the taught **incubator(14)**. The claimed “*electric heater thereunder ... temperature sensor*” has been read on the taught **heater(188)**. The claimed “*liquid dispenser*” has been read on the taught **depositing module(16)**. The claimed “*microprocessor*” has been read on the taught **computer control(20) and computer(542)**.

The cited prior art substantially teaches all of the features of the claimed invention except for the claimed “plural temperature sensors on the platform for sensing temperature of respective heated surface areas.” The Office has interpreted this limitation as requiring plural areas of the slides have an associated heat sensor to independently control the temperature of each area of slide. This could read on each slide possessing a temperature sensor and heater or on areas of the platform containing multiple slides with the same temperature sensor and responsive heater relationship.

Potter et al. teach in the abstract and columns 1-2 it is desirable to heat each slide independently based upon the specific reaction/conditions required for each slide. Potter et al. teach the appropriate sensor to control the heat for each slide.

It would have been within the skill of the art to modify Heidt et al. or Kerr et al. in view of Potter et al. and individually control the heating of each slide by a heating element and temperature sensor to gain the advantages of being able to heat individual slides for specific assays.

(10) Response to Argument

Appellant states Heidt et al. and Kerr et al. fail to disclose plural heated surface areas where each is heated by an electric heater there under and is in contact with a microscope slide. The Office does not agree and maintains both Heidt et al. and Kerr et al. teach heating elements underneath the slides.

Appellant states Potter et al. teach heating of liquid samples in wells as opposed to the claimed heating of microscope slides. Potter et al. has been properly cited as a secondary reference teaching that it is known to independently heat slides and the heating of samples in a well is not at issue.

The 9/23/08 1.132 Declaration has not been submitted in a timely manner and has not been considered. See MPEP 716.01. Additionally, the Declaration appears to be directed to opinion evidence without factual evidence and is making the ultimate legal conclusion that the rejection of rejection of record is untenable. MPEP 716.01(c) >III.< states "... opinion testimony, such testimony is entitled to consideration and some weight as long as the opinion is not on the ultimate legal conclusion at issue." The

same section of the MPEP further states "... an opinion as to a legal conclusion is not entitled to any weigh ...". Even if the 9/23/08 1.132 Declaration were timely, it does not appear it would be convincing to overcome the rejections of record for the reasons cited in MPEP 716.01(c) >III.< . Finally, in section "2." of Appellants' "Arguments ", Appellants state several different types of staining are characterized in the 9/23/08 1.132 Declaration. Even if the Declaration were considered, the remarks are not commensurate in scope with the pending claims because the claims are not directed to these specific types of staining.

In section 3, Appellant correctly characterizes Heidt et al. and Kerr as teaching method and apparatus for processing slides bearing biological samples with various reagents and heating the slides to a common temperature. Appellant correctly characterizes Potter as disclosing "an apparatus capable of independently regulating the heating of each sample in a sample container designed for rapid heat transfer to a set temperature." Appellant conclude that one having ordinary skill in the art would not have used the apparatus of Heidt et al., Kerr et al. or Potter et al. in the field of the invention, microscope slide staining. These remarks are not commensurate in scope with the pending apparatus or method claims. The pending claims require dispensing liquids to biological sample on microscope slide which is clearly taught by the all of the cited prior art. Additionally, with respect to the pending apparatus claims, the method of intended use is of no patentable moment. MPEP 2111.02>II.< characterizes In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus) and if a prior art

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structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997).

In section 4, Appellant state Heidt et al. and Kerr fail to teach conductive heating. These remarks are not commensurate in scope with the pending claims that do not require "conductive heating ." The Office maintains all of the cited prior art teaches heating by an electric heater underneath the slides and are indistinguishable from the pending claims.

Appellant states Potter et al. does not relate to microscope slide staining and fails to teach the claimed dispensing assembly. The Office maintains the instant claims are not limited to microscope slide staining because the apparatus or method steps for staining are not claimed.

Appellant further remarks that Potter et al. does not teach a sample dispenser. These remarks are not convincing because this Potter et al. is being applied as a secondary reference to teach the heating of individual slide.

In section 5, Appellant states the cited prior art is directed to a different field of invention. The Office is not convinced because the instant claim language requires biological material on slides which taught by the cited prior art.

Applicants' state the 35 USC 103 rejections of record are untenable because Potter cannot be used, because Potter is not related to the same field of endeavor (e.g. it seems Appellant is making a "non-analogous art" argument). The MPEP provides guidance in section 2141.01 as to what is considered analogous art. The court decided

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Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). The instant facts are the primary references are directed to the automated processing of slides encompassing all of the claimed elements except for an individual sensor beneath each slide to control each slide's temperature independently. The Office consulted Potter who also teaches an apparatus for manipulation of biological samples on slides. Potter teaches an individual sensor below each slide that regulates the temperature of each individual slide. This is advantageous to gain the advantage of tailoring a precise temperature for an individual sample. The Office maintains the primary references and Potter are both concerned with the same problem of heating and manipulating biological samples. The Office maintains Potter is analogous art and the rejections of record are proper.

In section 6, Appellant states even if there were motivation to combine Potter with Heidt et al. or Kerr et al., the combination would not have resulted in the claimed invention because the combination would not have been directed to microscope slides bearing biological samples. The Office disagrees and maintains all of the cited references are directed to slide bearing biological samples. Appellant states the well known meaning of a microscope slide is "a flat piece of glass on which and an object is mounted for microscopic examination." The Office maintains all of the cited prior art

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references teach a slide structure that supports a biological sample and are capable of microscopic examination. The Office maintains all of the references have been properly applied.

In section 7, Appellant states the instant invention enables automation of special staining techniques. These remarks are not commensurate in scope with the pending claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lyle A Alexander/
Primary Examiner, Art Unit 1797

Conferees:

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795